

REMARKS

Status of the Claims

Upon entry of the amendment above, claims 1-52 will be pending, claims 1, 16, 17, 19, 22, 48, and 50 being independent.

Summary of the Office Action

Claims 22-27 are rejected under 35 USC §102(b) as being anticipated by JOHNSON (U.S. Patent No. 4,438,574).

Claims 1-5, 11, 14, 15, and 18 are rejected under 35 USC §103(a) as being unpatentable over ABEL (U.S. Patent No. 3,289,328) in view of CAPLAN (U.S. Patent No. 2,003,105).

Claims 1-9, 11, and 14-18 are rejected under 35 USC §103(a) as being unpatentable over JOHNSON in view of ABEL and CAPLAN.

Claims 1, 2, 10, 14-16, and 18 are rejected under 35 USC §103(a) as being unpatentable over ZAINO (U.S. Patent No. 4,447,967) in view of ABEL and CAPLAN.

Claims 1-18 are rejected under 35 USC §103(a) as being unpatentable over NORTON et al. (U.S. Patent No. 4,451,996, hereafter "NORTON") in view of ABEL and CAPLAN.

Claims 19-21 are allowed.

Response to the Office Action

A. Summary of the Amendment

1. Specification

Paragraphs 0009 and 0015-0017 have been amended to improve their form and/or to provide antecedent basis for terminology in the claims.

2. Claims

Dependent claims 5-7 and 10 have been amended to improve their form, and dependent claims 16 and 17 have been amended by being rewritten in independent form.

Independent claim 22 has been amended to specify that the upper comprises an inner layer that comprises a “textile” material and that the outer protective covering positioned over said textile material is a “fine mesh lattice” material “for preventing penetration of foreign material.”

New dependent claims 28-52 have been added.

B. Request for Withdrawal of Rejection Based upon JOHNSON

Reconsideration and withdrawal of the rejection of claims 22-27, based upon JOHNSON, is kindly requested.

As mentioned above, independent claim 22 has been amended to specify that the upper comprises an inner layer that comprises a “textile” material and that the outer protective covering positioned over said textile material is a “fine mesh lattice ... for preventing penetration of foreign material.”

JOHNSON includes an inner layer 40 that is positioned only in the forepart section 16 of the upper. Rearward of the forepart section 16, the upper includes a main body section 18 (see column 4, lines 14-15), which includes a three-layer sandwich which includes a foam layer 26 between fabric layers 28, 30.

At the forepart section 16 is an inner layer 40 and an outer layer 42. The inner layer 40 is made of a “stretchable and moldable material” (column 4, line 34), “preferably made of leather or a leather-like material” (column 4, lines 36-37).

Further, and significant to a particular difference between JOHNSON and the invention of Applicant’s claim 22, as amended, is that the outer layer 42 of JOHNSON is only needed for the purpose of allowing the leather part of the upper (i.e., the forepart section 16) to be made thinner than it otherwise could be made if the forepart section 16 of the upper were made *only* of leather (i.e., if the outer layer 42 were to be omitted). See column 4, lines 42-61. That is, because the forepart section 16 is made of a “stretchable and moldable material,” i.e., thin leather, e.g., the outer layer 42 – made of non-stretchable synthetic mesh, such as nylon mesh (see column 4, lines 37-39) – keeps the thin leather from stretching “out of shape” (column 4, line 54).

Rather than using a thin leather, as does JOHNSON, Applicant uses a *textile* material as an inner layer, as specified in claim 22, as amended. JOHNSON fails to teach or suggest any function, other than the aforementioned stabilizing function, that would be performed by the outer layer 42. That is, it is only because the leather or leather-like material is sufficiently thin, or is otherwise stretchable and moldable, that the nylon mesh is used.

Applicant's use of a fine mesh lattice material, specified in claim 22, is used for the purpose of preventing penetration of foreign material to the textile material, which penetration could otherwise possibly become a source of discomfort to the wearer.

In addition to the foregoing points, Applicant respectfully traverses the rejection of claim 27, which claim calls for a reinforcing gusset extending forward to the outer protective coating on lateral and medial sides of the upper. Elements 32 and 34 of JOHNSON do not extend forwardly to the outer layer 40 of JOHNSON. Instead, the rearward extent of the outer layer 42 of JOHNSON stops at the seam shown in Fig. 4, which is the intersection of the forepart section 16 and the main body section 18.

Further, new claim 28, which depends from independent claim 22, calls for the ventilated textile material of the inner layer to comprise a vamp *and a sole* and extends rearwardly from the vamp *to the heel zone* of the article of footwear. Similarly, new claim 32 calls for the inner layer to enclose the toes and to extend *behind* the heel. By contrast, inner layer 40 of JOHNSON, like outer layer 42, (1) has a rearward edge at the seam shown in Fig. 4 and (2) is not part of a sole.

Still further, claims 29, 30, and 33, which depend from claims 22, 28, and 32, respectively, call for there being no seam on the medial side of the upper which extends upwardly from the bottom assembly through said extensible, ventilated, textile material of the upper. No cited document teaches or suggest such construction.

Further, new claims 31 and 34, depending from claims 28 and 32, respectively, call for a heel strap that extends over the rear portion of the ventilated textile material, and extends rearwardly and

upwardly on each of lateral and medial sides of the upper. JOHNSON has no such strap. Perhaps, the sandwich structure 26, 28, 30 of the main body portion of the portion 18 is believed by JOHNSON to be adequately dimensionally stable for his intended purposes. By contrast, Applicant's extensible, ventilated, textile material extends from the front (vamp) to the rear (heel) of the upper and is reinforced, in the invention as specified in claims 31 and 34, by a heel strap.

Still further, new claim 35 depends from independent claim 22 and calls for the liner to be an integral part of the article of footwear, fixed against removal for wear separate from the article of footwear. Directed to similar subject matter, new claim 36, also depending from independent claim 22, calls for the liner to be stitched in placed as an integral part of the article of footwear.

New claims 37-39 are serially dependent upon claim 22, claim 39 specifying that there is no inner sole inside the upper.

Applicant further traverse the rejection of claim 2, which claim calls for a heel stiffener arranged on the exterior of the upper. Although ABEL mentions (in column 1, lines 20-27) that a heel stiffener is well-known in the art, in column 1, lines 39-41, ABEL explains that, for his sport sock, "the use of a reinforcing liner or counter for the heel portion or the above described tassle-like member is unnecessary." Therefore, adding a heel counter/reinforcement would have been contrary to the express teaching of ABEL.

Further, Applicant traverses the rejection of claim 11. Although the use of insoles are used for shock-absorption, Applicant's use of a shock-absorbing sole *outside* of the upper is done for reasons explained in paragraphs 0039-0040 of his specification, i.e., to provide a so-called "inverted" construction, again relating to minimizing the number of seams so that, e.g., a shoe according to the invention can be comfortable while worn with a bare foot. Further, to emphasize this feature, new claim 40 calls for there being no insole inside the upper (i.e., although a shock-absorbing sole is positioned outside of the upper, as specified in parent claim 11).

At least for the foregoing reasons, reconsideration and withdrawal of the rejection based upon JOHNSON is kindly requested.

C. Request for Withdrawal of Rejection Based upon ABEL and CAPLAN

Reconsideration and withdrawal of the rejection, based upon the combination of ABEL and CAPLAN, are kindly requested.

Applicant has responded to this rejection, which has been carried over from the first Office action, and kindly requests that the rejection be withdrawn at least in view of the reasons of record. That is, this is not a new ground of rejection and Applicant's arguments regarding the rejection based upon ABEL + CAPLAN are not moot, as asserted on page 9 of the Office action.

According to Applicant's invention specified in claim 1, the liner of the invention is assembled together *only* by means of first and second assembly seams, *both* of such seams being on a *lateral side* of the upper of the article of footwear. Neither ABEL nor CAPLAN teach or suggest this limitation and, accordingly, reconsideration and withdrawal of the invention is kindly requested.

In the rejection, attention is directed to column 2, lines 1-8 of ABEL, as allegedly teaching seams on the lateral side of an upper. However, that passage fails to provide such teaching. Instead, from column 1, line 63, to column 2, line 3, ABEL makes clear that the illustrated sport sock is for a *right foot* and that the first seam 17 (referenced in the rejection to which Applicant here responds) is on the *left side* of said right foot. Accordingly, the seam 17 is on the *medial side*; not the lateral side. Therefore, in contrast to Applicant's claim 1, which calls for the longitudinal assembly seam (such as seam 44 in Fig. 2) and the vertical/substantially vertical assembly seam (such as seam 43 in Fig. 2) to be the *only* seams for assembling the liner together, ABEL teaches an *additional* seam, i.e., a seam which is different from the two seams mentioned in Applicant's claim 1, i.e., a seam 17 on the medial side of the upper. Such additional seam is a seam on the *medial side*. Further, in column 2, lines 26-32, ABEL explains that for the left foot, the seam 17 would be on the right side – again, the *medial side*, rather than the lateral side.

As confirmation, Applicant has attached page 111 of *The Complete Footwear Dictionary*, Krieger Publishing Company, Second Edition, 2000, which provides the following definition for “medial”: “The inner side of an object, such as the inner or medial side of the foot.”

Applicant recognizes, as mentioned in the Manual of Patent Examining Procedure, Section 2111, that during patent examination, claims are given their broadest reasonable interpretation. However, that instruction is qualified by the instruction that such interpretation must be “consistent with the specification.” In this regard, Applicant respectfully submits that one skilled in the art, interpreting claim 1 in a way consistent with the specification, would recognize that the expression “lateral side of the upper” refers to the outside side, i.e., the side along the “little” toe side, in contrast with the medial side of the upper. Further, in Applicant’s specification, with regard to structure (such as tightening quarters 21) that is located on both sides of the upper (as in paragraphs 0032 and 0035 and original claim 10), Applicant refers to medial and lateral sides. Further, Fig. 2 shows the seams 43 and 44 located on the lateral side of the upper.

To emphasize the foregoing difference between the invention and ABEL, new claim 40, which depends from independent claim 1, specifies that “said vertical or substantially vertical assembly seam is *not on a medial side* of the upper.”

By placing the assembly seams of the liner on the lateral side of the article of footwear (in contrast with the medial side thereof), Applicant has discovered that the foot is less injured by repeated rubbing of the foot against the seams, as explained in the specification. For example, during running, the part of the foot that is most stressed is the one going from the lateral side of the heel to front part of the medial side, which corresponds to the oblique unrolling of the foot.

Reconsideration and withdrawal of the rejection is kindly requested.

D. Request for Withdrawal of Rejection Based upon JOHNSON, ABEL and CAPLAN

Reconsideration and withdrawal of the rejection, based upon the combination of JOHNSON, ABEL, and CAPLAN, are kindly requested.

1. No Teaching or Suggestion of Seam on *Lateral Side*

Applicant requests that this ground of rejection be withdrawn at least for the same reasons given above in traverse of the rejection based upon the combination of ABEL and CAPLAN. In short, ABEL's longitudinal and vertical seams are on the *medial* side (rather than on the *lateral* side, as claimed by Applicant), and there is no teaching or suggestion as to why one skilled in the art would have modified ABEL's sport sock in a way that would have resulted in the invention. ABEL fails to teach or suggest a vertical seam, or a substantially vertical seam, on the lateral side of his upper.

Accordingly, the rejection of independent claims 1, 16, and 17 and the claims that depend therefrom, should be withdrawn at least for this reason.

2. New Claims 41-43: the Vertical Seam is Not on the Medial Side

To emphasize the foregoing difference, new claims 41-43, which depend from rejected independent claims 1, 16, and 17, respectively, specify that "said vertical or substantially vertical assembly seam is *not on a medial side* of the upper."

Of course, ABEL's seam 17 *is* on the medial side of the upper.

Accordingly, new claims 41-43 should be allowed.

3. The ABEL-CAPLAN Liner is Not Compatible with JOHNSON's Shoe

ABEL discloses (and claims) a sports sock, with no disclosure whatsoever of having it used as part of an article of footwear – i.e., as an upper of an article of footwear – like that of JOHNSON's or, even more generally, of having it used as part of an article of footwear that is to be attached to a bottom assembly. As stated in the beginning of ABEL's only claim, his invention is "A sports sock comprising a single piece of soft, flexible fabric material" What evidence or suggestion is there in ABEL, JOHNSON, or anywhere, that one skilled in the art of footwear would have considered taking ABEL's sports sock and using it as the upper of a shoe or boot, i.e., stitched or glued to a bottom assembly, including an outsole?

Further, as explained above in connection with Applicant's traverse of the rejection of claims 22-27, JOHNSON includes an inner layer 40 that is positioned only in the forepart section 16 of the upper. Rearward of the forepart section 16, the upper includes a main body section 18 (see column 4, lines 14-15), which includes a three-layer sandwich of fabric layers 28, 30, between which is a foam layer 26.

Why would one skilled in the art remove only the leather/leather-like lining 40 of the forepart section 16 and replace it with a mere sports sock? Would JOHNSON's main body section 18 remain after such replacement? Would the skilled artisan cut ABEL's sports sock in half and use the front half in place of the JOHNSON's forepart section 16?

Further still, how would the structural integrity provided by the three-layer sandwich 26, 28, 30 of the main body section 18 of JOHNSON's shoe be retained if it were to be replaced with a mere sports sock of ABEL (made of "terry stretch cloth," e.g., mentioned in column 2, lines 12-13)?

For reasons similar to those which resulted in the withdrawal of the rejection (in the first Office action) based upon a combination of DELGORGUE+ABEL+CAPLAN, i.e., "[s]tructural integrity of the upper would be completely sacrificed, inappropriate, and the objectives of [the primary reference] would not be met." As with the proposed modification of DELGORGUE, the modification of JOHNSON would involve the substitution of leather or a leather-like material (see column 4, lines 36-37 of JOHNSON) with terry stretch cloth or other "stretch type" material (column 2, lines 10-13 of ABEL).

At least for all of the reasons, and unanswerable questions, Applicant respectfully submits, the rejection that relies upon the proposed combination of JOHNSON+ABEL+CAPLAN should be withdrawn.

E. Request for Withdrawal of Rejection Based upon ZAINO, ABEL and CAPLAN

Reconsideration and withdrawal of the rejection, based upon the combination of ZAINO, ABEL, and CAPLAN, are kindly requested.

1. No Teaching or Suggestion of Seam on *Lateral Side*

Applicant requests that this ground of rejection be withdrawn at least for the same reasons given above in traverse of the rejection based upon the combination of ABEL and CAPLAN. In short, ABEL's longitudinal and vertical seams are on the *medial* side (rather than on the *lateral* side, as claimed by Applicant), and there is no teaching or suggestion as to why one skilled in the art would have modified ABEL's sport sock in a way that would have resulted in the invention. ABEL fails to teach or suggest a vertical seam, or a substantially vertical seam, on the lateral side of his upper.

Accordingly, the rejection of independent claims 1 and 16, and the claims that depend therefrom, should be withdrawn at least for this reason.

2. New Claims 41 and 42: the Vertical Seam is Not on the Medial Side

To emphasize the foregoing difference, new claims 41 and 42, which depend from rejected independent claims 1 and 16, respectively, specify that "said vertical or substantially vertical assembly seam is *not on a medial side* of the upper."

Of course, ABEL's seam 17 *is* on the medial side of the upper.

Accordingly, new claims 41 and 42 should be allowed.

F. Request for Withdrawal of Rejection Based upon NORTON, ABEL and CAPLAN

Reconsideration and withdrawal of the rejection, based upon the combination of NORTON, ABEL, and CAPLAN, are kindly requested.

1. No Teaching or Suggestion of Seam on *Lateral Side*

Applicant requests that this ground of rejection be withdrawn at least for the same reasons given above in traverse of the rejection based upon the combination of ABEL and CAPLAN. In short, ABEL's longitudinal and vertical seams are on the *medial* side (rather than on the *lateral* side, as claimed by Applicant), and there is no teaching or suggestion as to why one skilled in the art would have modified ABEL's sport sock in a way that would have resulted

in the invention. ABEL fails to teach or suggest a vertical seam, or a substantially vertical seam, on the lateral side of his upper.

Accordingly, the rejection of independent claims 1, 16, and 17 and the claims that depend therefrom, should be withdrawn at least for this reason.

2. New Claims 41-43: the Vertical Seam is Not on the Medial Side

To emphasize the foregoing difference, new claims 41-43, which depend from rejected independent claims 1, 16, and 17, respectively, specify that “said vertical or substantially vertical assembly seam is *not on a medial side* of the upper.”

Of course, ABEL’s seam 17 *is* on the medial side of the upper.

Accordingly, new claims 41-43 should be allowed.

G. New Claims

As mentioned above, new claims 28-52 have been added. Of these, claims 48 and 50 are independent. New claims 28-43 have been mentioned above in connection with the rejection of claims from which they depend. Below, Applicant summarizes new claims 44-52. Of these, the dependent claims should be allowed at least for the reasons advanced above with regard to the allowance of their parent claims.

New claim 44 depends from claim 18 and further specifies that the vamp and sole of the slipper/liner is embodied as a one-piece construction.

New claim 45 depends from claim 44 and further specifies that, on the lateral side of the upper, the vamp is attached to the sole by means of the longitudinal assembly seam between a free edge of the sole of the slipper and a lower edge of the vamp.

New claim 46 includes the same limitations as claim 45, but depends from claim 18, rather than from claim 44.

New claim 47 depends from claim 46 and further calls for a comfort tongue attached to the upper in an area above a foot of a wearer of the article of footwear. Applicant submits that there would have been no reason to have attached a tongue to ABEL's sport sock.

New independent claim 48 is similar in presentation to independent claim 1, but emphasizes certain features differently. At a minimum, claim 48 should be allowed at least for reasons given above with regard to claim 1. Further, claim 48 specifically calls for the upper of the article of footwear to include a medial side and a lateral side. In addition, claim 48 specifies that a first seam comprises a longitudinal assembly seam extending along "*said lateral side of said upper*" and that a second seam comprises a vertical assembly seam or a substantially vertical assembly seam, the second seam being on the lateral side of the upper.

New claim 49 depends from independent claim 48 and calls for the liner to be assembled together along the two seams to form a slipper that includes a vamp and a sole and, further, that a single piece of material comprises both the vamp and the sole.

New independent claim 50 is, like claims 1 and 48, directed to an article of footwear. It calls for a slipper assembled to a bottom assembly which includes an outer sole. Further, the slipper is specified as including a single piece of material that comprises a vamp part of the slipper and a sole part of the slipper, such single piece of material being continuous between the sole and the vamp along a predetermined length of a periphery of the sole (such as the predetermined length shown as a broken line in Fig. 3), such predetermined length extending along the medial side of the article of footwear and not along the lateral side of the article of footwear. This is not taught or suggested by a combination of ABEL and other documents of record.

New claim 51 depends from claim 50 and specifically calls for the two assembly seams, including only one that extends upwardly from the periphery of the sole.

Lastly, new claim 52 depends from claim 50 and calls for the single piece of material to be a textile material.

H. Replacement Sheets of Drawing

Although no objection was made regarding the drawings, Applicant has attached hereto for entry a complete set of Replacement Sheets, which are superior in quality to those originally filed.

SUMMARY AND CONCLUSION

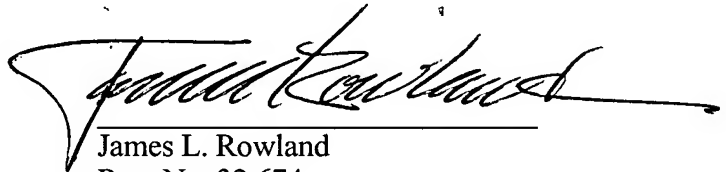
Reconsideration and allowance are respectfully requested for reasons advanced above.

Payment is being made herewith for a claim fee and for a fee for an extension of time for one month. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and/or complete to Deposit Account No. 19-0089.

Further, although a request for extension of time for one month is believed necessary at this time, if an additional extension of time were found necessary to render this reply timely and/or complete, Applicant requests such extension of time and the Commissioner is authorized to charge any necessary extension of time fee to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone number, fax number, or email address given below.

Respectfully submitted,
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Attachments: *The Complete Footwear Dictionary*, Krieger Publishing Company, 2nd Ed., 2000, p. 111.
Replacement Sheets of drawing (Sheets 1/4 – 4/4).